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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,019	10/20/2000	Shinichi Baba	1204-US	7461
9941	7590	10/17/2005	EXAMINER PHAN, TRI H	
TELCORDIA TECHNOLOGIES, INC. ONE TELCORDIA DRIVE 5G116 PISCATAWAY, NJ 08854-4157			ART UNIT 2661	PAPER NUMBER

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,019

Applicant(s)

BABA ET AL.

Examiner

Tri H. Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 14-15 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2 and 4-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 14-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment/Arguments

1. This Office Action is in response to the Response/Amendment filed on June 27th, 2005. Claims 1-2 and 4-13 are now canceled. Claims 3 and 14-15 are now pending in the application.

Claim Objections

2. Claim 14 is objected to because of the following informalities:

In claim 14, lines 5-6, the words "the CONTACT field" and "the SIP REGISTER" should be changed to -- a CONTACT field -- and -- a SIP REGISTER --.

Appropriate corrections are required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 3 and 14-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 3 is directed to a data structure for use in a SIP-compliant network, which is not a "process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."

Claims 14-15 are rejected under 35 U.S.C. 101 because the claim 14 (and thus depending claim 15) simply recite "... computer readable medium having executable instructions...", which is not executed by a computer system, such as a microprocessor.

Claims 3 and 14-15 are rejected under 35 U.S.C. 101 because the claimed recitation of the data structure includes, for example an original IP address, a previous IP address, a current IP address, an original IP address (see claim 3) and computer readable medium having executable instructions, which is not executed by the processor, are considered as non-statutory subject matter, i.e., results in the claim which is not a proper descriptive material's claim that is not defined functional interrelationships between the data structure, which is limited to the practical application under 35 U.S.C. 101. See for example *MPEP*, Section 2105-1 and <http://www.uspto.gov/web/offices/com/hearings/software/analysis/> under Section Non-Statutory Subject Matter of the claimed invention complies with 35 U.S.C. § 101.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,697,354 B1, Borella et al. (Borella) in view of U.S. Patent 6,266,405 B1, Madour et al. (Madour) and in further view of applicant's admitted prior art (AAPA).

Regarding claim 14, Borella discloses, "a system for reducing the amount of time a mobile station takes to register and configure itself in a visiting... network environment, comprising a computer readable medium having executable instructions to (col. 2, lines 56-62): equip a... register node with a DHCP client node and co locating said...registrar node with a DHCP server node to enable said... registrar node to assign an IP address to said mobile station thereby reducing acquisition time" (col. 22, lines 41-45 where the roaming node registers with the visiting networks gateway router and is assigned an IP address which is then communicated to the home network and as read, the registering and assigning are all done within the gateway router; it should be noted that gateway router functions equivalently to a DHCP server (and therefore all nodes under it are also DHCP nodes)". However, Borella lacks what Madour discloses, the visiting network is SIP-compliant (figure 6, element 121 shows the use of a SIP network), the register node is SIP (figure 6 where if the network is SIP-compliant then the nodes are SIP).

It would have been obvious to one of ordinary skill in the art to use a SIP-compliant network for not only the purpose of design choice but also to incorporate additional options in the signaling (Madour, col. 6, lines 19-23). The motivation for adding additional options is to increase the features available to the user and network for established communications, for example, caller ID.

Borella and Madour however, lack what AAPA discloses, designating "an additional option for the CONTACT field of the SIP REGISTER method, which option indicates

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registration or hand-off (specification, page 2, lines 5-9 where it is indicated that the CONTACT field is specifically used for registration information)."

It would have been obvious to one of ordinary skill in the art at the time of invention to include the CONTACT field for registration for the purpose of registering newly connected or disconnected nodes. The motivation for doing this is to keep the overall state of the network up to date.

Allowable Subject Matter

6. Claim 3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

7. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri H. Phan, whose telephone number is (571) 272-3074. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on (571) 272-3126.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231



or faxed to:

(571) 273-8300

Hand-delivered responses should be brought to Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office, whose telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BRIAN NGUYEN
PRIMARY EXAMINER

Tri H. Phan
October 7, 2005